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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,303	09/28/2001	Matthew Whitehead	BAI525-520/01786	5038

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HEAD, JOHNSON & KACHIGIAN
228 W 17TH PLACE
TULSA, OK 74119

EXAMINER	
SHEPARD, JUSTIN E	

ART UNIT	PAPER NUMBER
2424	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/966,303	WHITEHEAD, MATTHEW	
	Examiner	Art Unit	
	Justin E. Shepard	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 July 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 9-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 9-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/1/09 has been entered.

Response to Arguments

Applicant's arguments filed 7/1/09 have been fully considered but they are not persuasive.

Page 5, paragraph beginning with "Applicant's invention":

In response to applicant's argument that the preview video data is transmitted separately from the general EPG data so that more EPG data could be available, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The applicant argues that if both the EPG data and the preview data are transmitted together, that every program would therefore have preview data associated with it and therefore memory would be filled with preview data, which would limit the

amount of general EPG data that could be stored. As is seen in the Lawler reference (figure 5, parts 128, 130 and 132), shows that not all the programs have a preview video associated with them, which would allow for more general EPG data to be stored. Therefore the prior art structure is capable of performing the intended use, and it meets the claim limitation.

Page 5, paragraph beginning with "On Page 2":

The applicant again argues that Barrett teaches that the EPG data and the video preview data are transmitted together, shown specifically on column 9, lines 44-46. This portion states that the EPG could provide video clips or previews for various shows. The examiner is interpreting this portion to mean that the preview video would be played back in a portion of the EPG as seen in Lawler (figure 3B, part 80; column 5, lines 42-50). As this portion does not state anything about transferring data, it cannot be used by the applicant as proof that the data is transferred together.

Page 5, paragraph beginning with "In addition":

The applicant continues to argue that Barrett teaches that the EPG data and the preview video data are transmitted together. The cited portion is about data being inserted into the video content as is common with MPEG data streams, but is silent about whether the EPG data and the preview data are transmitted together. The examiner feels that the disputed portions of Barrett are not clear cut as the applicant suggests, but are broad enough to support both the applicant's and the examiner's

interpretations. Instead of arguing over the language found in Barrett, the examiner suggests that the applicant amends the claims to clearly get around the Barrett reference.

Page 6, paragraph beginning with “Applicant believes”:

The applicant continues to argue that Barrett teaches that the EPG data and the preview video data are transmitted together. The applicant cites US Patent 6,874,161, which is incorporated by reference in the Barrett reference, as teaching this idea. Once again, this portion only teaches that data is transmitted during the off-peak television viewing times, and is silent about transmitting preview data at all. As stated above, the issue at hand, seems to be the interpretations of these references.

Page 7, paragraph beginning with "Further":

In response to applicant's argument that the preview video data is transmitted separately from the general EPG data so that more EPG data could be available, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Page 7, paragraph beginning with "On Pages":

The applicant argues that Lawler teaches that the memory would not be large enough to store the video data. The portions cited by the applicant (column 6, lines 2-4 and 54-64) do not support the applicant's interpretation of the reference.

The applicant continues to argue that the preview portions are stored remotely. The examiner agrees with this assertion, but the argument is moot as Barrett is used to teach this limitation (Office Action, page 5).

Page 7, paragraph beginning with "The Examiner":

The applicant argues that the examiner is requiring proof of the applicant's assertion, without providing any proof of the examiner's assertions. As stated above, the examiner is stating interpretations of the references while the applicant seems to be stating that his interpretations as fact. The references are broad enough for multiple interpretations. Instead of arguing the different interpretations, the examiner suggests that the applicant clearly amends around the cited prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler (US Patent 6,868,551) in view of Barrett in view of Klosterman.

Referring to claim 1, Lawler discloses a television system, said system comprising:

a broadcast data receiver (figure 1, part 20) for receiving data which is broadcast from a remote location (figure 1) and which includes video, audio and auxiliary data (column 3, lines 62-65; column 5, lines 61-67), processing said data to generate video, audio (column 4, lines 12-17) and auxiliary services via an on-screen display (figure 3B) and speakers connected with the broadcast data receiver (column 7, lines 30-32);

an electronic program guide which is generated from said auxiliary data on screen to provide information and facilitate user selection of programs for viewing at that instant or in the future (column 5, lines 61-67, 15-19, and 39-40); and

a storage means provided as a part of the broadcast data receiver (figure 2, part 68) in which data is downloaded and held in storage locally in memory for subsequent retrieval and display upon the selection of a program from the electronic program guide (column 5, lines 42-50; column 6, lines 54-61) and to which a portion of the video and/or audio data relates (column 6, lines 62-64), the stored portions of data having identification data such that upon user selection to receive information on a program using the electronic program guide the broadcast data receiver identifies the identification data for the selected program (column 5, lines 42-50) and searches the for stored video and/or audio data with matching identification data (column 6, lines 62-64),

and if found, processes the same to generate video and/or audio therefrom for said display (figure 5, box 130).

Lawler does not disclose a system wherein the storage means in the form of a hard disc memory; and wherein a plurality of portions of video and/or audio data are stored on the memory; said video and/or audio data to be stored is downloaded separately from said auxiliary data at designated off peak time according to when the broadcast data receiver is not in use by a user and when the broadcast data receiver is less likely to be in use for other functions; and

wherein said video and/or audio data is transmitted to the broadcast receiver in a single transport stream.

In an analogous art, Barrett teaches a system wherein the storage means in the form of a hard disc memory (column 4, lines 15-17); and wherein a plurality of portions of video and/or audio data are stored on the memory; said video and/or audio data to be stored is downloaded separately from said auxiliary data at designated off peak time according to when the broadcast data receiver is not in use by a user and when the broadcast data receiver is less likely to be in use for other functions (column 9, lines 41-51 and 63-65; Note: the applicant's original specification (page 7, second paragraph), it uses the middle of the night as an example of an off peak time, which the examiner interprets 3am as being falling into this time period).

At the time of the invention it would have been obvious for one of ordinary skill in the art to the use the hard drive and video downloading during off peak times taught by Barrett in the system disclosed by Lawler. The motivation would have been that hard

disk storage devices offer large amounts of storage at a cheaper price than solid-state storage devices; and that downloading during off peak times saves on bandwidth consumption (column 9, lines 41-51).

Lawler and Barrett do not disclose a system wherein said video and/or audio data is transmitted to the broadcast receiver in a single transport stream.

In an analogous art, Klosterman teaches a system wherein said video and/or audio data is transmitted to the broadcast receiver in a single transport stream (column 2, lines 8-11).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the single transport stream taught by Klosterman to the system disclosed by Lawler and Barrett. The motivation would have been that Klosterman teaches a system that cannot receive other data while the preview data is downloading, so it would have been well known in the art to transport this data as a single stream of data.

Referring to claim 2, Lawler discloses a television system according to claim 1 wherein said retrieval and display of said video and/or audio data from the storage means is in response to a user request for further information with respect to a particular program displayed on said electronic program guide (column 5, lines 42-50).

Referring to claim 3, Lawler discloses a television system according to claim 1 wherein a video and/or audio clip or trailer for a particular program is generated from said data retrieved from storage and shown to the user (column 6, lines 54-61).

Referring to claim 4, Lawler discloses a television system according to claim 3 wherein the user has the option, after or during viewing the clip or trailer, to select the program at that instant (column 5, lines 39-40) or in the future via said electronic program guide.

Referring to claim 10, Lawler discloses a television system according to claim 1 wherein said data video data being transmitted for the generation of the clips and trailers are shown in a portion of said display screen (figure 3B, box 94; column 5, lines 42-50).

Referring to claim 11, Lawler discloses a television system according to claim 1 wherein further auxiliary information is generated via said data stored in the storage means for retrieval upon the selection of a related program via said electronic program guide (column 5, lines 42-57).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler in view of Barrett and Klosterman as applied to claim 1 above, and further in view of Ludwig.

Referring to claim 9, Lawler and Barrett do not disclose a television system according to claim 1, wherein said video data being transmitted for the generation of clips and trailers is a low resolution.

In an analogous art, Ludwig teaches a television system according to claim 1, wherein said video data being transmitted for the generation of clips and trailers is a low resolution (column 78, lines 49-55).

At the time of the invention it would have been obvious for one of ordinary skill in the art to download the clips at lower resolutions, as taught by Ludwig, in the system disclosed by Lawler and Barrett. The motivation would have been to conserve bandwidth needed to transfer video files (Ludwig: column 58, lines 20-21).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/
Supervisory Patent Examiner, Art Unit 2424

JS